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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/544,204

08/02/2005

Sherif Makram-Ebeid

FR 030010

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10/15/2009

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

KOZIOL, STEPHEN R

ART UNIT

PAPER NUMBER

2624

MAIL DATE

DELIVERY MODE

10/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/544,204	Applicant(s) MAKRAM-EBEID ET AL.	
	Examiner STEPHEN R. KOZIOL	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 12-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. In view of the appeal brief and claim amendments filed on 24 December 2008, PROSECUTION IS HEREBY REOPENED. The claim amendments have been entered and considered. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. § 101 as not falling within one of the four statutory categories of invention. *In re Bilski* was decided October 30, 2009. The previous Office action was mailed May 29, 2008. Accordingly, the instant '101 rejection could not have been advanced at an earlier date. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. § 101 must:

- (1) be tied-to a particular machine or structure , or
- (2) transform underlying subject matter (such as a particular article or material) to a different state or thing,

known as the "machine-or-transformation" test. See *In re Bilski*, 545 F.3d 943 USPQ2d 1385 (Fed. Cir. 2008) (*cert granted*). See also the January 7, 2009 memorandum issued by former Deputy Commissioner for Patent Examining Policy, John J. Love, titled Guidance for Examining Process Claims in view of *In re Bilski* (signed January 7, 2009) ¹ under 35 U.S.C. § 101. The instant claims neither transform underlying subject matter (i.e. a particular article) nor positively tie to particular machine or structure that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

¹ Link to the memo:

http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf
or, from uspto.gov: Policy and Law→Patents→Memorandum to the Examining Corps→ Guidance for Examining Process Claims in view of *In re Bilski* (signed January 7, 2009).

In order to be “tied-to” particular machine or structure, structure which performs or executes critical steps of the claimed method must be positively recited in a step or steps significant to the basic inventive concept. Structure in statements of intended use or purpose, whether in the claim or preamble, will not be sufficient.

Also, “the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.” Id. at 24, (emphasis added) (i.e. the structure must be significant to the basic inventive concept, not merely data gathering or displaying). Structure will not be read from the specification into the claim.

Instant independent claims 1 and 11 recites a “system” and “method” respectively that fails to specify structure that is significant to the basic inventive concept. That is, the “particular machine” tasked with performing the critical analyzing and synthesizing steps is not recited. Hence, claims 1 and 11 are not tied-to a particular machine. Furthermore, the steps recited in the body of independent claim 1 and 11 do not necessarily require the use of a particular machine (i.e. nothing in the body of the independent claims as recited necessarily requires a computer or its equivalent to perform the critical steps of the method). Therefore, claims 1-11 fail the machine prong of the machine-or-transformation test. (Claims 12 and 13 both recite particular machines in the form of an “examination apparatus” and a “computer program product” respectively).

Furthermore, “an article” is not transformed into a different state or thing by any of the steps of claims 1-11. The transformation prong of the Bilski test for patent eligible subject matter stems from In re Abele, 684 F.2d 902 (CCPA 1982), particularly, the discussion

surrounding Abele's claims 5 and 6. The combination of Abele's claims 5 and 6, is presently considered an example of a valid transformation, because:

- 1) data being transformed (i.e. the "particular article") represents "real world data" (e.g. Abele uses X-ray attenuation data);
- 2) the "particular article" is transformed into a different state or thing by a non-trivial step of the method (e.g. the steps recited in claim 5 of Abele); and
- 3) the transformed data is depicted as an external representation of a physical object (e.g. the transformed data is displayed).

Instant claims 1-11 fail to recite data equivalent to a particular article, and fail to transform the data into a different state or thing. Hence, claims 1-11 also fail the "transformation" prong of the "machine-or-transformation" test.

For a more detailed explanation of this or other Office policy, Applicants may refer to the Office of Patent Legal Administration (OPLA):

- (571) 272-7701 – General patent examination legal and policy guidance

Allowable Subject Matter

3. Claims 1-11 would be allowable if amended to overcome the rejections under 35 U.S.C. § 101 as set forth herein. Claims 12 and 13 are objected to for their dependence on rejected base claims. The prior art of record, alone or in combination, fails to fairly teach or suggest the method comprising analyzing means comprising means to estimate at each image point a probability measure of the presence of a type of feature interest which can be an elongated anisotropic feature or a generally circular or spherical isotropic feature and to determine from said probability measure a weighting control model yielding a weighting vector for the user to

Art Unit: 2624

control synthesized adaptive kernels at each image point, as required by instant independent claims 1 and 11.

Contact

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Koziol whose telephone number is (571) 270-1844. The examiner can normally be reached on Monday - Friday 9:00 - 5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached at (571) 272-7413 . Customer Service can be reached at (571) 272-2600. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13 October 2009
/srk/

/Samir A. Ahmed/

Supervisory Patent Examiner, Art Unit 2624